
Remarks/Arguments

Procedural History

Prior to entry of this paper, the following claims were pending: 1 - 20. In this paper, claims 2, 17, and 18 have been amended, and new claim 21 has been added.

Claim 20 was canceled in this paper. After entry of this paper, claims 1 - 19 and 21 are now pending.

Claim rejections under 35 U.S.C. § 102

The examiner rejects claims 1 - 3, 7 - 11, and 13 - 18 under 35 U.S.C. § 102(b) as being anticipated by Friedman (U.S. Patent 5,421,350).

The examiner states in part, "Friedman discloses a contraceptive prophylactic condom (10) comprising a closed end (16) and an open end (32) opposite the closed end, an intermediary portion (20) between the ends generally in a frusto-conical shape (fig. 1), wherein the open end forms a leak proof enclosure of its periphery about the glans penis portion, wherein said condom contain a securing means effective to maintain a non-movable position (col. 6, lines 7-11)."

With all due respect, the examiner appears to omit a limitation of the claim from the examiner's analysis. Prior to amendment by this paper, claim 1 reads, with emphasis added,

A contraceptive prophylactic condom effective to prevent the transmission of seminal fluid during sexual intercourse and/or fellatio, comprising a closed end and an open end opposite the closed end, an intermediary portion between said ends generally in a frusto-conical shape and/or mimicking the size and shape of a glans penis of the male sex organ, wherein the open end forms a circumferential leak proof enclosure of its periphery about the glans penis portion at a position above the sulcus, and wherein said condom contains a securing means effective to maintain a non-movable position on the glans penis during intercourse or fellatio.

Unlike the present invention, Friedman discloses a contraceptive prophylactic condom wherein the open end encompasses all of the sulcus. To quote Friedman, "an internal retaining 12 means within the center of the flange lip 14 which then becomes integrately [sic.] secured under the lip 30 on the head of a penis allowing the rest of the penis shaft to be exposed, thus, increasing sensitivity during intercourse. The retaining means 12 is angulrly [sic.] designed in a functional relationship to encompass the angle of the lip 30 of the head of the penis and the angle of the penis shaft 24." Column 8, lines 43 - 50. See also Friedman figure 3, which shows a flange lip 14 and an internal retaining means 12 which wraps around and encompasses the entire head of a penis, including the top portion of the penis shaft. The concluding sentence in the quote, above, from column 8, lines 43 - 50 of Friedman highlights that the "retaining means 12" has two angles, one matching the angle of the penis shaft, the other matching the angle of the lip of the head of the penis, as can be noted in a review of Friedman figure 3. The

Remarks/Arguments -- Continued

condom in Friedman thus clearly comes into contact with the entire circumference of the top of the penis shaft and the entire sulcus.

In contrast, the disclosed invention includes the limitation that the condom include a circumferential leak proof enclosure of its periphery about the glans penis portion at a position above the sulcus, the sulcus being identified in the application as the margin between the top of the penis shaft and the penis glans, below the lip on the head of the penis. See also figures 2, 3, and 4 of the application.

In addition to being disclosed in the figures, this limitation is discussed in the specification as follows, with emphasis added:

[0030] An open end 28 of condom 16, opposite from closed end 18 at the opposite end of main body 20, completely surrounds, encloses and encompasses a portion of the glans penis with the circumferential periphery 30 thereof extending around the glans penis just short of the sulcus 32.

[0031] In another preferred embodiment, as shown in FIG. 3 in an elevational perspective transparent view, open end 28 will have a circumferential periphery extending around the glans penis without encompassing or enclosing both a frenulum, or a portion thereof, and the sulcus 32, thereby exposing all or a portion of the frenulum and sulcus and the great majority of the penis to oral contact during fellatio for maximum sensory pleasure to a fellatee while still containing and/or preventing transmission of pre-ejaculate and ejaculate.

[0032] Turning now to FIG. 4, there is shown in a transparent elevational perspective view additional embodiments of the present invention. In these embodiments, the periphery of open end 28 is fitted with an integral retaining means, such as a elastomeric band, to extend around the glans penis thereby covering a portion of the corona area and to fit snugly around and under at least a portion of the lip on the head of the penis and wherein said portion is juxtaposed to a portion of the sulcus. This embodiment is thought to provide for additional positional securement to the glans penis during use, whether it be sexual intercourse or fellatio. Again, an adhesive means may also be used in conjunction with the integral, annual retaining ring, or any other securing means contemplated.

Page 14 – 15 of the originally filed specification. Emphasis added.

To summarize, then, the condom described in Friedman does not conform to the glans penis, but rather has a symmetrical shape when viewed from above, covering the entire glans penis, the frenulum, and all of the sulcus. See, for example Friedman figures 1, 2, and 3. In contrast, the presently disclosed invention does not encompass or enclose both a frenulum, or a portion thereof, and the sulcus.

To further clarify that the disclosed invention conforms more precisely to the glans penis (in contrast to Friedman), claim 1 is amended with this paper to remove the reference to “a frusto-conical shape,” leaving that the intermediate portion mimics the size and shape of a glans penis. While “a frusto-conical shape” may include a shape which mimics the glans penis, it might also be understood by some to also include a shape, such as described in Friedman, larger than the glans penis and which encompasses the entire sulcus.

Remarks/Arguments -- Continued

This paper further provides a new dependent claim 21 to describe an embodiment in which the disclosed condom includes an elastomeric band which fits around a portion of the lip of the head of the penis and wherein said portion is juxtaposed to a portion which is not covered (see figures 4.A. and 4.B.).

On the basis of the foregoing, the applicant respectfully requests that the examiner reconsider this objection to claim 1 in light of these arguments and in light of the claim amendment.

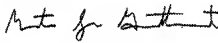
Claims 2 – 3, 7 – 11, and 13 – 18 depend from claim 1. For the reasons stated above, these dependent claims are similarly patentable over Friedman.

Claim Rejections under 35 U.S.C. § 103(a)

The examiner has objected to claims 4 – 6, 12, and 19 as being unpatentable over Friedman in view of Vistins, Hopkins, Ellington, Manning, and Winkler. The applicant respectfully disagrees that Friedman discloses the invention as claimed and as such claims are now amended. As described above, the applicant has noted differences between the present application and Friedman. The applicant respectfully requests that the examiner re-consider whether Friedman discloses the claimed invention and that the examiner find that Friedman does not disclose the claimed invention.

The applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,
NEWMAN & NEWMAN

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Please note: A replacement sheet for drawing figure 1 is provided as page 8 of this paper.